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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/689,051	10/13/00	GRAUZER	A PA0476.AP.US

QM12/1109

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EXAMINER	
VARMA,S	

ART UNIT	PAPER NUMBER
3711	5

DATE MAILED: 11/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/690,051	Grauzer et al.
Examiner	**Art Unit**
Sneh Varma	3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-40* is/are pending in the application.

4a) Of the above, claim(s) *None* is/are withdrawn from consideration.

5) ☒ Claim(s) *None* is/are allowed.

6) ☒ Claim(s) *19-24* is/are rejected.

7) ☒ Claim(s) *None* is/are objected to.

8) ☒ Claims *1-18 and 25-40* are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)
16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4
18) ☐ Interview Summary (PTO-413) Paper No(s). _____
19) ☐ Notice of Informal Patent Application (PTO-152)
20) ☐ Other:

DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-7, drawn to an apparatus, classified in class 273, subclass 149R.

II. Claims 8-13, 14-18, 25-28, 33-38, and 40, drawn to a card handler with a microprocessor, classified in class 463, subclass 22.

III. Claims 19-24, drawn to a method, classified in class 273, subclass 292.

IV. Claims 29-32, and 39 drawn to a method, classified in class 273, subclass 29.

2. The inventions are distinct, each from the other because of the following reasons: Inventions III and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process of "resupplying randomly arranged cards" can be practiced with another equipment such as one where cards are counted at other locations and the apparatus claimed in invention I can be use to sort other pieces of amusement devices requiring shuffling.

3. Inventions III and II are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for

making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case the process of "resupplying randomly arranged cards" can be practiced with another equipment such as one without a processor control and the apparatus claimed can be use to sort other pieces of amusement devices requiring shuffling and sorting.

4. Inventions III and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions III and IV claim methods for resupplying cards and performing a security check.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. Because these inventions are distinct for the reasons given above and the search required for Group III is not required for Group I, II, and IV, restriction for examination purposes as indicated is proper.

7. During a telephone conversation with Mr. Mark A Litman on November 2, 2001 a provisional election was made with traverse to prosecute the invention of Group III, claims 19-24. Affirmation of this election must be made by applicant in replying to this Office action. Claim 1-18 and 25-40 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 19-24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 15-18 of U.S. Patent No. 6,254,096 in view of Lorber et al. U.S. Patent No. 4,586,712.

Claims 15-18 of U.S. Patent No. 6,254,096 claim substantially the same the invention as recited in the instant Claims 19-24, except for the step of counting the cards. Lorber teaches the

steps of counting the cards within the specified area within the automatic card shuffling apparatus by using a count indicator 142 (Column 6, lines 10-30) and a microprocessor. It would have been obvious to one having ordinary skill in the art at the time the invention was made, to have added the step of counting in the device of U.S. Patent No. 6,254,096 to enhance the appeal of the automatic card shuffling method by providing added information about deck counts, etc. to ensure that cards are not missing. It would have been obvious in view of Lorber to count in any of a variety of places for added security.

Claim Rejections - 35 U.S.C. § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 19 and 22-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Lorber et al. '712 (Lorber).

Lorber discloses a method for continuously resupplying randomly arranged cards, the method comprising the steps of : providing a card receiver 28 for receiving cards 30 to be processed (Figures 1-4; Column 4, lines 5-7); providing a single stack of card-receiving compartments 44 generally adjacent to the card receiver(Column 4, lines 28-30) and means for moving the stack relative to a card moving mechanism 112 (Column 5, lines 50-57; providing a

card-moving mechanism between the card receiver and the stack 102 and moving the cards from card receiver to the card receiving compartments (Col. 5, lines 33-57); providing second card receiver 55 for receiving processed cards (Col. 4, lines 45-64); providing a second card moving mechanism 104 for moving cards from the compartments to the second card receiver (Col. 5, lines 40-50); and counting cards (Col. 6, lines 10-30) within specified areas within the card handler; providing a processing unit for controlling the card moving mechanism and the means for moving the stack so that cards in the card receiver are moved into random compartments 44 (Col. 6, lines 10-68; col. 7, lines 45- 56); the designation and selection is performed before card moving operations begin (Col. 8, lines 35-68).

Claim Rejections - 35 U.S.C. § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

14. Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lorber.

Lorber discloses the invention as recited above. However, Lorber fails to disclose all the locations where the counting occures. It would have been obvious to one having ordinary skill in the art at the time the invention was made that Lorber counting occurs in different places and the selection and designation of cards is control by the count indicator (Col. 6, lines 10-30).

The Lorber device is a means to achieve the same function as that claimed for the invention. Since the Applicant has failed to provide any evidence of unexpected results using the claimed invention which could contradict the recitation above, clearly the Applicant's claimed counting locations are obvious and lack criticality. The Applicant has not presented new and unexpected results to substantiate that the counting locations claimed are critical.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Varma whose telephone number is (703) 308-8335. The examiner can normally be reached on Monday to Friday from 8:00 A.M. - 4:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, Paul Sewell, can be reached on (703) 308- 2126.

The Official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9302 and the fax phone number After Final Office Action is (703) 872-9303. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

November 1, 2001

Sneh Varma, Patent Examiner

Art Unit 3711

Paul T. Sewell
Supervisory Patent Examiner
Group 3700

Attachment for PTO-948 (Rev. 03/01, or earlier)
6/18/01

The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

1. Correction of Informalities -- 37 CFR 1.85

New corrected drawings must be filed with the changes incorporated therein Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability Extensions of time may NOT be obtained under the provisions of 37 CFR 1 136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made other than correction of informalities, unless the examiner has approved the proposed changes

Timing of Corrections

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a)

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.